

REMARKS

Claims 1-44 were rejected as being anticipated under 35 USC §102(b) by Hagan et al., U.S. Patent No. 6,734,886 B1. Reconsideration and withdrawal of these rejections are respectfully requested, for the following reasons.

I. Claim 1 and its dependent claims

The invention of claim 1 is

a method for a first server to select content to be displayed on a computer accessing a Web site of a second server.

Therefore, the claimed invention is a method that requires: 1) a first server that selects content; 2) a second server having (hosting) a web site that displays the selected content; and 3) a computer that accesses the web site of the second server. In contrast, Hagan et al. simply shows a web server 54 and a user computer 90 that accesses the web site of the web server 54. A registration authority server 82 is also shown, but such registration server 82 does not select content to be displayed on the user's computer accessing the web site of the web server 54. The registration server is only used for authentication purposes – to assign and validate UAIs (Universal Anonymous Identifiers).

The claimed method for a first server to select content to be displayed on a computer accessing a Web site of a second server of independent claim 1 recites steps of:

collecting user identification data from the computer accessing the Web site;
sending the collected user identification data to the first server;
retrieving user information corresponding to the user identification data from a database of user information accessible to the first server;
applying the retrieved user information to a rule base including a plurality of rules;
selecting content to be displayed on the second server's Web site based upon a result of the application of the retrieved user information to at least one of the plurality of rules, and
causing the Web site to display the selected content to the accessing computer.

However, the Office supports its §102(e) rejection of this claim by stating that “Hagan discloses a design allowing users to enter their information which is stored within a database remote to the user (column 6, lines 14-30, Hagan). The user information is then used by a web site when the user views the website, and the website is customized based on the user information (Column 4, lines 28-46, Hagan).” The Office then states that the claimed rules are inherently present in Hagan et al.

However, undisclosed and unsuggested in Hagan et al. are any teachings of a first server selecting content to be displayed on a second server's web site and causing the Web site to display the selected content to the accessing computer. Again, the claimed method requires three computers:

1. the claimed first server (e.g., the Merchant Server 140 of Fig. 1);
2. the claimed second server (e.g., the Affiliate server 130 of Fig. 1), and
3. the claimed accessing computer (e.g., 120 in Fig. 1).

Moreover the first server must receive the user identification data, retrieve user information corresponding to this data, apply this information to a rule base, select content to be displayed on the second server's web site, and cause the web site to display the selected content to the accessing computer. In contrast, in Hagan et al., the web server authenticates the user (Fig. 5) and the same web server provides customized information to the user based upon a keyword search (Fig. 7), based upon a link table (Fig. 8) or based upon the browsing history of similarly situated users (Fig. 8) – neither figures teach or suggest obtaining the customized content from a merchant server coupled to a rule base. There is no disclosure or suggestion in Hagan et al. of one server selecting content for another web server to display on a web site that is displayed by yet another computer, as shown, described and claimed in the present application.

The anticipation rejection of claim 1 and of its dependent claims, therefore, should be reconsidered and withdrawn. The same is, therefore, respectfully requested.

II. Independent claim 18 and its dependent claims

What the Office describes as anticipating the claimed invention is a system in which a user enters information in a database, which information is later accessed and used to customize the web site they view. However, such an interpretation of claim 1 ignores the claim language and the recited steps of claim 1. As the Examiner recalls, in a rejection under 35 U.S.C. §102(e), each and every claimed element must be present in the applied reference. In the present case, therefore, Hagan et al. must show each claimed step or it cannot anticipate claim 1.

Claim 18 recites:

A system comprising:
a merchant Web server;
an affiliate Web server, the affiliate Web server being coupled to the merchant Web server over a computer network;
a database of user information accessible to the merchant Web server;
a rule base including a plurality of configurable rules, the rule base being accessible to the merchant Web server;
a first process to collect a user identification from a computer accessing a Web site controlled by the affiliate Web server and for sending the collected user identification to the merchant Web server along with a request for content;
a second process for retrieving user information from the database corresponding to the collected user identification, and
a third process for applying user information obtained from the database to the plurality of rules and for returning selected content to the affiliate Web server in response to the request for content, the returned content being selected based upon a result of applying the user information to the plurality of rules.

In support of the anticipation rejection, the Office only contends that Hagan et al. "discloses a design allowing users to enter their information which is stored within a database remote to the user", and asserts that a database is a server with storage means and that Hagan et al.'s database 86 is, in fact, a server ("the database ... is a server such as the claimed affiliate server"). At the outset, if Hagan et al.'s database (any one of databases 81, 86 or 88) is the

affiliate server (an assertion with which Applicants vehemently disagree), where in Hagan et al. is the claimed merchant server? Alternatively, if the claimed database is the affiliate server, where in Hagan et al. is the database 81, 86 or 88 shown to be “accessible to the merchant Web server”, as required by the claim? The answer is that Hagan et al. teaches nothing of the sort. In Hagan et al., there is but a single server (reference number 54 in Fig. 4) that is involved in the generation of the customized web site that is accessed by the user’s computer. Again, Hagan et al.’s “Registration Authority Server” 82 is only used to issue/manage UAIs and to verify the user’s current Health Plan. To anticipate the claim, Hagan et al. must show each of:

1. a Merchant server;
2. an Affiliate server;
3. a database accessible to the Merchant server;
4. the claimed rule base, and
5. each of the first through third processes that operate upon the claimed Merchant Server, the claimed Affiliate server, the claimed database and the claimed rule base in the manner recited.

In his case, Hagan et al. does not disclose any first process “to collect a user identification from a computer accessing a Web site controlled by the affiliate Web server and for sending the collected user identification to the merchant Web server along with a request for content”. If Hagan et al.’s web server 54 is analogized to the claimed affiliate server, then Hagan et al.’s Registration Authority Server 82 must be the claimed merchant Web server. However, Hagan et al.’s server 82 is not a web server, but merely a server that manages UAIs. If, on the other hand, Hagan et al.’s Registration Authority Server 82 is analogized to the claimed affiliate server, Hagan et al. would still fail to anticipate the claim, as the claimed first process requires the collection of user identification “from a computer accessing a Web site controlled by the affiliate Web server”, and Hagan et al.’s Registration Authority server does not control any Web site, as required by the claim.

It is also respectfully submitted that the Office is not free to combine two separately recited and distinct elements into a single element for the purpose of making a §102 rejection. In this case, the Office contends that the recitations drawn to the database and affiliate server are met by a database, although both Hagan et al. and the present application shows these elements to be functionally separate entities. The applied reference must show or describe each claimed element in order to anticipate a claim. Hagan et al. does not do this, as demonstrated above. Reconsideration and withdrawal of the 35 USC §102(e) rejection applied to claim 18 and its dependent claims are, therefore, respectfully requested.

III. Independent claim 35 and its dependent claims

Claim 35 recites:

A method of delivering personalized content from a first server to a computer accessing a second server, comprising the steps of:
receiving a request for the personalized content from the accessing computer, the accessing computer having accessed a Web page that includes embedded code configured to send the request for personalized content to the first server over a computer network along with selected user identification data;
retrieving user information corresponding to at least one of the user identification data and the accessed Web page from a database of user information accessible to the first server;
applying the retrieved user information to a rule base including a plurality of rules;
selecting content to be posted in the accessed Web page based upon a result of the application of the retrieved user information to at least one of the plurality of rules, and
sending at least one of the selected content and an address of the selected content to the accessing computer for posting into the accessed Web page.

The Office rejected claim 35 on exactly the same grounds as were advanced relative to independent claim 1 – even though the language of each claim is different. The embodiment of claim 35 specifies that the content selected by the first server is posted into the accessed Web page controlled by the second server. In Hagan et al., however, only the Web Server 54 generates Web pages. The Registration Authority Server 54 is only used for authentication and verifying Health Plan membership, and not for selecting content “for posting into the accessed Web page”,

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as required by claim 35. Moreover, Hagan et al.'s Figs. 6, 7, 8 and 9 set out explicitly how his Web site is customized. Not a single one of these flowcharts or the corresponding written portion of Hagan et al.'s disclosure makes any mention or suggestion of "applying the retrieved user information to a rule base including a plurality of rules; selecting content to be posted in the accessed Web page based upon a result of the application of the retrieved user information to at least one of the plurality of rules, and sending at least one of the selected content and an address of the selected content to the accessing computer for posting into the accessed Web page." as claimed in claim 35. In Hagan et al., there is no mention of rules, nor any mention of selecting content to be posted in a Web page based upon one or more of these rules, nor any mention or suggestion of sending the selected content and/or the address of the selected content to the accessing computer for posting into the accessed Web page, as required by claim 35. The dearth of teachings or suggestions in Hagan et al. regarding any of these claimed elements is fatal to the Office's §102(e) rejection.

Specifically regarding the claimed rules in each of the independent claims, the Office relies on *inherency* as a basis for rejecting the claims.

IV. The Examiner's reliance upon inherency is misplaced, in error and does not conform with the USPTO's own standards concerning inherency.

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

Section 2112 of the MPEP (from which the passage above was taken) defines the standards to be followed by USPTO Examiners when formulating rejections based on inherency and clearly defines the Examiner's burden of proof. Each of the MPEP §2112 standards for inherency will now be addressed in turn.

Something Which Is Old Does Not Become Patentable Upon The Discovery Of A New Property: The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

In the present case, however, no "new property" is claimed. What is claimed, on the other hand, is **structure and claimed method steps**, namely methods and systems for delivering personalized content from a first server to a computer accessing a second server. Moreover, the pending claims do not recite a "new use, new function or unknown property" that is inherently present in the prior art. Indeed, structure (e.g., rule base, merchant server, etc.) that is not disclosed in the cited reference cannot be said to have a property, use or function – new or otherwise.

A Rejection Under 35 U.S.C. 102/103 Can Be Made When The Prior Art Product Seems To Be Identical Except That The Prior Art Is Silent As To An Inherent Characteristic: Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, 35 U.S.C. 102/103 rejection is appropriate for these types of claims as well as for composition claims.

In the present case, however, the claims do not recite the system in terms of function, property or characteristic, but in terms of structure. Moreover, the Hagan et al. reference is not "silent" as to the structure of an otherwise disclosed rule base, because no such rule base is disclosed and no rules are taught or suggested at all. The claims of the present invention, on the other hand, positively recite a plurality of rules, a rule base accessible to a merchant server and also recite selecting content for posting into the accessed web page based upon the application of user information to one or more of the plurality of rules. Nothing of the sort is taught or in any way "inherent" in Hagan et al. For a proper inherency rejection, the structure of the cited

reference must be the same as that of the claimed invention and the differences between the cited reference and the claimed invention must be related to some property, use or characteristic that is inherent in the structure of the device disclosed in the cited reference. This is not the case here, in which the Hagan et al. reference nowhere discloses or suggests the claimed structure.

The MPEP continues:

Examiner Must Provide Rationale Or Evidence Tending To Show Inherency:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations omitted)(The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.)." (Emphasis Added).

The situation here is even further removed from the facts in the *In re Robertson* case cited in the MPEP above, in that the Hagan et al. demonstrably fails to expressly or inherently disclose an the claimed rules, rule base, affiliate and merchant servers and the structure and functional interplay between these elements, as claimed herein. Hagan et al. does not teach or suggest any rules or any rule base and does not teach the claimed affiliate and merchant web server configured as claimed. The Office's dependence upon inherency, therefore, is misplaced, as *In Re Robertson* teaches us that the applied reference must at least teach each of the claimed elements, and must teach that such elements are configured to perform the same function as the claimed elements. The computer system of Hagan et al. does not perform the same function as the claimed elements of the pending claims, as noted above. It is further submitted that the

Examiner has presented no evidence tending to show that persons of skill in this art would necessarily recognize the Hagan et al.'s system as having any of the functionality or structure claimed. The MPEP continues:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Examiner, in this case, has failed to provide such a basis in fact and/or technical reasoning to support his contention that the allegedly inherent rules necessarily flow from the teachings of Hagan et al. The Office's reasoning that "customizations are made based on a user and are different for each user" only defines the term "customization", but provides no rational, or basis in fact or technical reasoning. Again, the rejected claims do not recite an inherent characteristic or structure of the Hagan et al.'s method or system, but structure, processes and steps that are nowhere disclosed or suggested therein.

Section 2112.02 of the MPEP provides detailed guidance relative to inherency and process (method) claims:

2112.02 Process Claims

PROCESS CLAIMS - PRIOR ART DEVICE ANTICIPATES A CLAIMED PROCESS IF THE DEVICE CARRIES OUT THE PROCESS DURING NORMAL OPERATION

Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986) (The claims were directed to a method of enhancing color effects produced by ambient light through a process of absorption and reflection of the light off a coated substrate. A prior art reference to *Donley* disclosed a glass substrate coated with silver and metal oxide 200-800 angstroms thick. While Donley disclosed using the coated substrate to produce architectural colors, the absorption and reflection mechanisms of the claimed process were not disclosed. However, King's specification disclosed using a coated substrate of Donley's structure for use in his process. The Federal Circuit upheld the Board's finding that "Donley inherently performs the function disclosed in the method claims on appeal when that device is used in 'normal and usual operation' " and found that a

prima facie case of anticipation was made out. *Id.* at 138, 801 F.2d at 1326. It was up to applicant to prove that Donley's structure would not perform the claimed method when placed in ambient light.). See also *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977) (Applicant claimed a process for preparing a hydrolytically-stable zeolitic aluminosilicate which included a step of "cooling the steam zeolite ... at a rate sufficiently rapid that the cooled zeolite exhibits a X-ray diffraction pattern" All the process limitations were expressly disclosed by a U.S. patent to Hansford except the cooling step. The court stated that any sample of Hansford's zeolite would necessarily be cooled to facilitate subsequent handling. Therefore, a *prima facie* case under 35 U.S.C. 102/ 103 was made. Applicant had failed to introduce any evidence comparing X-ray diffraction patterns showing a difference in cooling rate between the claimed process and that of Hansford or any data showing that the process of Hansford would result in a product with a different X-ray diffraction. Either type of evidence would have rebutted the *prima facie* case under 35 U.S.C. 102. A further analysis would be necessary to determine if the process was unobvious under 35 U.S.C. 103.); *Ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993) (The Board rejected a claim directed to a method for protecting a plant from plant pathogenic nematodes by inoculating the plant with a nematode inhibiting strain of *P. cepacia*. A U.S. patent to *Dart* disclosed inoculation using *P. cepacia* type Wisconsin 526 bacteria for protecting the plant from fungal disease. *Dart* was silent as to nematode inhibition but the Board concluded that nematode inhibition was an inherent property of the bacteria. The Board noted that applicant had stated in the specification that Wisconsin 526 possesses an 18% nematode inhibition rating.).

In this case, it has been shown above that Hagan et al.'s system is not "the same as a device described in the specification for carrying out the claimed method", as the PTO's own guidelines require. Therefore, is cannot "be assumed the device will inherently perform the claimed process." During its "normal and usual operation", Hagan et al. does not teach any merchant server that accesses a rule base or access a plurality of rules that are then used to select content that is sent to an affiliate server for posting into a web page accessed by yet another computer, as claimed herein. To assert otherwise, it is respectfully submitted, is to read structure and functionality in Hagan et al. that is not present therein.

Again, it is the properties or functions of a claimed apparatus that may be held to be inherent in an applied reference, when the product disclosed in the applied reference and the claimed invention are the same. When the claimed invention is a process (method claim), the "same device" must still be disclosed in the prior art and such same device must carry out the claimed process during its "normal and usual operation." Such has not been shown in Hagan et

al. These deficiencies are believed to render the Examiner's inherency argument fatally defective, again by the USPTO's own standards. It is respectfully submitted that inherency may not be used to circumvent the strict requirements of 35 USC §102, in which each and every claimed structure or process step must be present in a single reference. In view of the foregoing, reconsideration and withdrawal of the §102(e) rejections of the above-identified claims are respectfully requested.

Applicants' attorney, therefore, respectfully submits that all claims are allowable and that the present application in condition for an early allowance and passage to issue. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below.

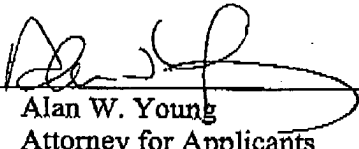
No fee is believed to be due with this communication. The Commissioner is authorized to charge any fees which may be required to Deposit Account No. 15-0635, referencing Docket No. OID-2000-022-01.

Respectfully submitted,

Date:

JAN 20, 2005

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